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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR.	ATTORNEY DOCKET NO.
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09/182,279 10/29/98 COPPERSMITH

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EXAMINER
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TM02/0228

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ART UNIT	PAPER NUMBER

2165  
DATE MAILED:

02/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/182,279

Applicant(s)  
Coppersmith et al.

Examiner  
Cuong H. Nguyen

Group Art Unit  
2165



☒ Responsive to communication(s) filed on Nov 30, 2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-21 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

S.N.: 09/182,279

Art Unit: 2165

#### DETAILED ACTION

1. This Office Action is the answer to the communication (the RESPONSE UNDER 37 C.F.R. §1.111) received on 11/30/2000, which paper has been placed of record in the file.

2. Claims 1-21 are pending in this application.

#### Response

3. Applicants' arguments received on 11/30/2000 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C. §103(a) rejections. The examiner reviewed thoroughly the cited prior art again and he recognizes that those cited references are very obvious with what the applicants claimed.

4. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5. A shortened statutory period for reply to this Final Action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

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pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this Final Action.

6. The examiner is unpersuasive with the concept of protecting goods against counterfeiting using smart tags that the applicants presented. The examiner submits that the use of smart cards, or electronic tags (a derivative/different use of smart cards) are notoriously well-known for one with skill in the art (see the article title "Metrorail to take a high-tech trip with smart card" by the Washington Post, printed on 7/05/1998; it provides some background for a technology of using smart card/electronic tag). This article said that: "Smart cards -- which have been around for years in Europe", and (for the reader) "to know how many riders it has, but also who they are, where they get on the subway, where they go, and even what they have for lunch", and "Embedded in the card is a small computer chip that stores data. When the card is passed over the gate's reader, its antenna sends a signal to the gate to open. Computer chip: Holds approximately 30 times the data that can be stored on a magnetic-stripe card", and "Card reader: Rider passes card in front of the machine's reader to begin a transaction and again at the end of the transaction to register any changes", and "Non-contact smart card

reader: Card is passed within three inches of reader. Riders can pass their entire wallet or purse over the disk. Display window shows how much is on the card", these explanations suggest an obvious use of smart card/smart tags/electronic tags in reading the information contained inside those cards/tags; from there, a purpose of protecting goods against counterfeiting is easily achievable. That is the sole purpose of this application.

7. In using this analogous application, the examiner relies on *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992),

A prior art reference is analogous if the reference is in the field of applicant's endeavor **or**, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned; and in

*Lamont v. Berguer*, 7 USPQ2d 1580 (BdPatApp&Int 1988), the court rules that section 103 requires us to presume that the artisan has full knowledge of the prior art in his field of endeavor and the ability to select and utilize knowledge from analogous arts.

A. In re *Hiniker Co.*, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court ruled: "The name of the game is the claim."

B. Although operational characteristics of a system may be apparent from the specification, we will not read such characteristics into the claims when they cannot be clearly

connected to the structure recited in the claims. See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. See also **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990); ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim").

8. The examiner submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; therefore, arguments in the amendment are not convincing while the claims are still read-on prior arts' suggestion. See **In re Van Geuns**, 988 2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

9. The examiner disagrees about a conclusion on page 2, para. 5 (of the response received on 11/30/2000). There is a conflict of applicants' opinion between the phrase "While no agreement was reached with regard to claims 1-20, the Examiner agreed that claim 21, which is directed to detecting goods being sold in a

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parallel market, deserves additional attention since the prior art of record does not address these limitations" (detecting goods is enough in this application, whether "in a parallel market" or not, this doesn't contribute much weight because its obviousness, the information in the tag's memory would have this routing information), and "Claims 1-21 remain presented for reconsideration. Applicants note with appreciation the Examiner's indication that the previous grounds of rejection have been withdrawn.", the Examiner didn't indicate that the previous grounds of rejection have been withdrawn.

10. About an argument on the 1<sup>st</sup> para. of page 5 (of the response received on 11/30/2000) that: "Fuji is absolutely unrelated to using smart cards to authenticate goods or to identify counterfeit goods. Further, none of the secondary prior art, relied on by the Examiner in combination with Fuji, remotely teaches or suggests using a smart card to authenticate goods to detect counterfeits". The examiner disagrees, Fuji clearly identifies GemPlus as a company that in a business of manufacturing, at least, inherently having analogous limitations as applicants claimed about GemPlus's electronic tags using in retailed business. Applicants argue that: "the article does not teach or suggest attaching a smart card to a product or good such the authenticity of the good can be readily verified" (see page

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5, 2<sup>nd</sup> para. of the applicants response). In response to this argument, the examiner submits that this conclusion is not true, please think about the concept of using smart card for authenticity/(getting secure/correct information), the suggestion of attaching a electronic tag/(smart card) to a product for a purpose is not an inventive concept because it is so obvious with one of skill in the art for one purpose like this. The smart card/electronic tag, itself, contains secured information to trace/authenticate, among other things, original sources.

11. The examiner shows following court cases that a factual reference can be used:

A. In re Langer, 183 USPQ 288 (CCPA 1974), it said:

Even though effective date, for prior art purposes, of many of the references is subsequent to applicant's earliest filling date, the references are properly-cited for purpose of showing a fact.

B. In re Wilson, 135 USPQ 442, (CCPA 1962), the court rules:

A bulletin published by a chemical company could be used as evidence of factual characteristics of prior art in foam products in determining patent-ability of a process for making foamed polyester materials, even though date of the publication was later than the filing date of the patent application.

C. In re Sheckler, 168 USPQ 716 (CCPA 1971), the court rules:



It is not necessary that a reference actually suggest changes or possible improvements which applicants made.

D. *In re Fine*, 5 USPQ2d 1596 (CA FC 1988), the court rules:

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art **or** that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." The "objective teaching" here are capabilities of preventing/verifying/authenticating/protecting .etc.

E. *In re Bozek*, 163 USPQ 545 (CCPA 1969), the court rules:

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

F. *In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967), the court rules:

"Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did,

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although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

G. In re **Beattie**, 24 USPQ2d 1040 (CA FC 1992), the court rules: "Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventors, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole."

H. In re **Dillon**, 16 USPQ2d 1897 (CA FC 1990), the court rules: "Each situation must be considered on its own facts, but it is not necessary in order to establish a prima facie case of obviousness that both a structural similarity between a claimed and prior art compound be shown and that there be a suggestion in or expectation from the prior art that the claimed compound or composition will have the same or a similar utility as one newly discovered by applicant."

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**I. Orthopedic Equipment Company, Inc. et al. v. United States,**

217 USPQ 193 (CA FC 1983), the court rules:

"Fact that two disclosed apparatuses would not be combined by businessmen for economic reasons is not same as saying that it could not be done because skilled persons in art felt that there was some technological incompatibility that prevented their combination; only latter fact is telling on non-obviousness issue. "

**J. In re Bozek,** 163 USPQ 545 (CCPA 1969), the court rules:

"Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred."

**K. In re Jacoby,** 135 USPQ 317 (CCPA 1962), the court rules:

"Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be presumed to know something about radiators apart from what references disclose"; "it is immaterial that reference does not disclose specific function set forth in applicants' specification, since this is merely an additional attribute possessed by reference structure which would be obvious to one skilled in the art in a use which one skilled in the art, following teachings of prior art, might make of it"

**L. Merck & Co. Inc. v. Biocraft Laboratories Inc.,** 10 USPQ2d 1843 (CA FC 1989), the court rules:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

M. *In re Boe*, 148 USPQ 507 (CCPA 1966), the court rules: Rejections may be based on prior art teachings phrased in terms of a non-preferred embodiment or as being unsatisfactory for the intended purpose.

N. *In re Bozek*, 163 USPQ 545 (CCPA 1969), the court rules: "Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

O. *In re Keller, Terry, and Davies*, 208 USPQ 871 (CCPA 1981)

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

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12. On pg.8, 1<sup>st</sup> para. of the response, the applicants argue that: "The Examiner has cited Fuji which teaches nothing more than the existence and popularity of smart cards." The examiner disagrees because this article obviously suggest more than that, it obviously discloses about smart/electronic tags using in retailed stores ((see FUJI-KEIZAI USA, INC. pg.1, e.g. electronic tags, and GPR400, a smart card reader in PC Card format to instantly encrypt and decrypt reading data).

A. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court ruled: "The name of the game is the claim."

B. Although operational characteristics of a system may be apparent from the specification, we will not read such characteristics into the claims when they cannot be clearly connected to the structure recited in the claims. See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. The cited prior art disclose concepts that meet the claimed subject matter: electronic/smart tags. See also **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990); ("The US is strictly

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an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim").

13. About an argument that the examiner did showing a lower level of prima facie of obviousness under 35 U.S.C. §103(a), he notes that prima facie case already establishing by presenting a fact from prior art, the court also rules:

*In re Fine*, 5 USPQ2d 1596 (CA FC 1988), the court rules:  
The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references", the examiner submits that above requirement is satisfied.

14. The following rejections are based on the current examiner's broadest reasonable interpretation of the claims; *In re Pearson*, 181 USPQ 641 (CCPA 1974).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

15. Claims 1, 5-6, 8-10, 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over an article of FUJI-KEIZAI USA, INC.

A. Referring to claim 1: It is directed to a system for verifying an authenticity of a product, comprising:

- a tag is attached to a product, it can store authentication information in encrypted form; and a reader equipped with a decryption key for reading said authentication information from said tag (to verify said product is authentic).

The above limitations are obviously included in GEMPLUS product (see FUJI-KEIZAI USA, INC. pg.1, e.g. electronic tags, and GPR400, a smart card reader in PC Card format to instantly encrypt and decrypt reading data); (see also Chew (US. Pat. 5,901,303) suggests a similar application (e.g. a tag having a memory) with a microprocessor embedded in a smart card).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a readily available information/system on the market from GEMPLUS since it is well-known on this particular field of retail marketing, and it makes a similar compact system for verifying an authenticity.

of a product (see In re **Fine** 5 USPQ2d 1596 (CFFC 1988), In re **Gershon, Goldberg, and Neiditch**, 152 USPQ 602 (CCPA 1967).

B. Re. to claim 5: It is quite obvious to one with skills in the art to further (with the rationale for rejection in claim 1) including a reader (for authenticating a product) in front of a consumer prior to purchase of the product (see In re **Larson**, 144 USPQ 347 (CCPA 1965) for an **integration** characteristic).

C. Re. to claim 6: It is quite obvious to one with skills in the art to further (with the rationale for rejection in claim 1) including a reader for reading an electronic tag without physically contacting said tag (see FUJI-KEIZAI USA, INC. pg.1, e.g. RF/ID products from GEMPLUS do not need physically contacting a tag for reading information).

D. Re. to claim 8: It is very well-known to one with skills in the art to further (with the rationale for rejection in claim 1) imply that authenticating product information is directed to a product 's manufacturer (e.g. a company names "Sony").

E. Re. to claim 9: It is very well-known to one with skills in the art to further (with the rationale for rejection in claim 1) indicate that authentication information is specific to a product (e.g. a product serial number).



F. Re. to claim 10: It is very well-known to one with skills in the art to further (with the rationale for rejection in claim 1) including a label having authentication information printed thereon to be verified against the authentication information read by a reader (e.g. a product serial number).

G. Re. to claim 18: This claim has a similar limitation as claim 10 although it is a method claim; hence, the same rationale is incorporated.

H. Re. to claim 15: It is obvious to one with skills in the art (with the rationale for rejection in claim 1) to have authentication information including information for authenticating an electronic tag (e.g. an analogous application is the BIOS file in a PC with information about a configuration of that PC -embedded information-, see a court case for an **integration** characteristic).

In summary, the same analysis and reasoning set forth in the rejection of claim 1 are applied to these claims also because they are directed to a system that comprises similar means with very obvious limitations.

16. Claim 2 is directed to a system for verifying an authenticity of a product, wherein a tag is a smart card (see FUJI-KEIZAI USA, INC. pg.1, e.g. electronic tags, and GPR400, a smart card reader in PC Card format to instantly encrypt and decrypt reading

data); (see also Chew (US. Pat. 5,901,303) suggests a similar application (e.g. a tag having a memory) with a microprocessor embedded in a smart card).

17. Claim 3 is directed to a system for verifying an authenticity of a product, wherein a tag is embedded into a product/(a product packaging) (e.g. see also Storch et al. (US Pat. 5,367,148) Figs. 2-3, the rationales for rejection for claim 1 are incorporated).

18. Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Mob (US Pat. 5,740,250).

It is directed to a system for verifying an authenticity of a product, wherein information is encrypted using a private key, and is decrypted using a public key (see '250 claims 21, and 26; the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of GEMPLUS with the suggestions of Mob for verifying the authenticity of a product in a conventional way, because these information are readily available at that time.

19. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Guillou et al. (US Pat. ...,634).

20. Claims 7 is directed to a system for verifying an authenticity of a product, wherein a zero-knowledge protocol is used (see at least '634 the abstract, the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of GEMPLUS with the suggestions of Guillou et al. for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be done in a conventional way.

21. Re. to claim 17: This claim has a similar limitation as claim 7 although it is a method claim; hence, the same rationale is incorporated for rejection.

22. Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Storch et al. (US Pat. 5,367,148).

A system for verifying the authenticity comprises a product serial number. The rationales for rejection for claim 1 are incorporated herein.

FUJI-KEIZAI INC.'s article do not expressly disclose above limitation.

However, Storch et al. show that this limitation is very well-known (see at least '148 Fig. 3).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of GEMPLUS with the suggestions of Storch et al. 's disclosure for verifying the authenticity of a product serial number, because this information is very well-known, and the verifying system would be sufficient with a product's serial number.

23. Claim 12 is rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., since it is interpreted as: A system for verifying the authenticity comprises a graphical image/indicia (of the product) (this limitation is very well-known on the market, e.g. an apple for an "Apple computer" .etc., the rationales for rejection for claim 1 are incorporated herein).

24. Claims 13, 20 are rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of DiCesare et al. (US Pat. 5,971,435).

A. Re. to claim 13: It is interpreted as a system for verifying the authenticity comprises an ownership history (of the product). The rationales for rejection for claim 1 are incorporated herein.

FUJI-KEIZAI USA, INC.'s article does not expressly disclose above limitation.

However, DiCesare et al. show that this limitation is very well-known (see '435 4:40-56, and claim 13).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of GEMPLUS with the suggestions of DiCesare et al. 's disclosure for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be sufficient with a product's past history.

B. Re. to claim 20: This claim has a similar limitation as claim 13 although it is a method claim; hence, the same rationale is incorporated.

25. Claims 14, 19 are rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Matyas et al. (US Pat. 5,164,988).

A. Re. to claim 14: The rationales for rejection for claim 1 are incorporated herein.

It is interpreted as a system for verifying the authenticity, wherein (authentication) information is erased after being read.

FUJI-KEIZAI USA, INC.'s article does not expressly disclose above limitation.

However, Matyas et al. show that this limitation is very well-known (e.g. see '988 19:25-26, and 20:2-4).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Gemplus's system with a

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suggestion of Matyas et al. for verifying the authenticity of a product, because these information are readily available at that time, and the verifying task would be known as "done" with that product.

B. Re. to claim 19: This claim has a similar limitation as claim 14 although it is a method claim; hence, the same rationale is incorporated.

26. Referring to claims 16, 21: They are rejected on obviousness reasons under 35 U.S.C. § 103(a) since limitations of these claims comprise similar claims' limitations of claims 1-15 above. The same analysis and reasoning set forth in the rejection of claims 1-15 are applied to these claims also because they are directed to a method that using similar means for verifying the authenticity of a product/(detecting products in a parallel market)(as the system in claims 1-15) to perform claimed steps.

Claim 21 is broad in its preamble because it only claims an application in detecting counterfeit products in a market. The only extra feature that is different from above claims 1-20 is: **verifying a routing information of said product** (other modified clauses for above step are obvious for one with skills in the art). Upon reviewing, above limitation is inherently suggest with GemPlus smart tags because the tags contain a memory;

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therefore, routing information is very well-known be written in a memory "chip".

It would have been obvious to one of ordinary skill in the art at the time of invention to implement GEMPLUS's system with a suggestion of Matyas et al. for verifying the authenticity/information of a product, because these information/technologies are readily available at that time, and the verifying task would be known as "done" with that product. Therefore, Claim 21 is rejected also based on obviousness reason.

#### Conclusion

27. Claims 1-21 are rejected.

28. These references are considered pertinent to applicants' disclosure.

- FUJI-KEIZAI USA, INC., "Top 40 high tech companies in Europe: GEMPLUS, FRANCE: Analysis of factors/strategies for company's success, future plans and business opportunities in this industry", published on July 1997.

- Edelstone et al., "Microchip Technology - Company Report" by PRUDENTIAL SECURITIES INC., published on 11/24/1995.

- "GEMPLUS announces integration of GemSAFE with IBM Smart Card Security Kit" from Business Wire, p.1323, published on 10/21/1998.

- "GEMPLUS to showcase GemSAFE Smart Card Security Solutions at RSA Conference." from Business Wire, p.1418, published on 1/14/1999.

- Reid, article title "Metrorail to take a high-tech trip with smart card" by the Washington Post, printed on 7/05/1998; it provides some background for using smart card/electronic tag.

29. Notes:

A. The examiner submits that these claims' limitations are obvious because GEMPLUS, Storch et al., Deo et al., Chew and Matyas et al. need not necessarily spelled-out exactly claimed languages, because their suggestions also directed to a similar system for a clinic transaction system; their limitations are not limited to described embodiments in their inventions. It is reasonable that various modifications and variations of their systems would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of the invention. Although GEMPLUS, Storch et al., Deo et al., Chew and Matyas et al. inventions have been described in connection with specific preferred embodiments, it should be understood that their limitations as claimed should not be unduly limited to such specific embodiments. Having described preferred embodiments of the present invention with reference to the accompanying drawings, it is to be understood that the present invention is



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not limited to the above-mentioned embodiments and that various changes and modifications can be effected therein by one skilled in the art without departing from the spirit or scope of the present invention as defined in the appended claims.

B. MPEP 2113 Product-by-Process Claims [R-1]:


"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

C. About structural limitations in method claims: When considering a method claim, patentable weight is given to the structure on which the claimed process is carried out in determining the obviousness of that process; *In re Kuehl*, 177 USPQ 250 (CCPA 1973); and to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure, *ex parte Pfeiffer*, 1962 C.D. 408 (1961).



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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

  
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